

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KEVIN P. LEAHY and COREY D. JONES

Appeal No. 1999-0936
Application No. 08/890,263

ON BRIEF

Before McCANDLISH, *Senior Administrative Patent Judge* and
STAAB and GONZALES, *Administrative Patent Judges*.

STAAB, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claim 3 in this broadening reissue application based on appellants' U.S. Patent No. 5,528,828, issued June 25, 1996. Claims 1 and 2, the only other claims pending in the application, have been allowed.

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By way of background, this reissue application is related to appellants' copending reissue application SN 08/890,252. An appeal from the examiner's final rejection in the related '252 reissue application is decided concurrently herewith.

Appellants' invention pertains to a method for fabricating a helicopter main rotor blade. Appealed claim 3 reads as follows:¹

3. A method for spreading and inserting a leading-edge sheath [onto] in combination with a blade subassembly, comprising the steps of:

mounting the leading-edge sheath between [upper] first and [lower] second rows of suction cups;

imparting synchronized movement to the [upper] first and [lower] second rows of suction cups to an engaged position wherein the suction cups are in abutting engagement with respective OML surfaces of the leading edge sheath;

generating suction forces in the [upper] first and [lower] second rows of suction cups to cause the suction cups to hold the respective OML surfaces of the leading-edge sheath;

imparting synchronized movement to the [upper] first and [lower] second rows of suction cups to an operating position to cause the leading-edge sheath to be spread apart; and

¹Reissue claim 3 is presented in the form prescribed by 37 CFR § 1.173, namely, with matter to be omitted by reissue enclosed in square brackets and with additions made by reissue underlined.

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inserting the spread-apart leading-edge sheath
[onto] in combination with the blade subassembly.

No references are relied upon in the final rejection of
claim 3.

Reissue claim 3 stands rejected under 35 U.S.C. § 112,
first paragraph, as being based upon a patent disclosure that
fails to provide descriptive support for the invention as now
claimed.^{2,3}

The examiner's rationale for the rejection is found on
page 2 of the final rejection and reads as follows:⁴

The change to first and second instead of upper and
lower is considered new matter [T]he terms

²In the final rejection, the examiner also objected to the specification and drawing as containing new matter; however, this objection has not been carried forward in the examiner's answer. Had the examiner maintained the objection, we would have been obligated to consider the merits thereof. See M.P.E.P. § 2163.06 (II) REVIEW OF NEW MATTER OBJECTIONS AND/OR REJECTIONS.

³Based on the designation of elements 66U and 66L as upper and lower suction cups, and the depiction of the apparatus in Figure 3 as being supported on a ground surface, it is apparent that Figure 3 is a partial elevation of the apparatus. Accordingly, the description of Figure 3 in the BRIEF DESCRIPTION OF THE DRAWINGS section of the specification should be amended to reflect that Figure 3 is a partial elevation view of Figure 2 rather than a partial plan view thereof.

⁴Upon consideration of appellants' arguments in the main brief, the standing 35 U.S.C. § 112, first paragraph, rejection is no longer based on changing "onto" in patent claim 3 to "in combination with" in reissue claim 3. See page 2 of the examiner's answer.

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first and second are much broader than the terms upper and lower. For example[,] first and second could mean left and right or forward and rearward. There is no disclosure, either in words or pictures, in applicants [sic, applicants'] specification, to anything other than upper and lower. Therefore[,] to try to use broader terms than this is new matter.

The examiner is correct that the claim language "first" and "second" does not expressly appear in the original patent in describing the rows of suction cups 66U, 66L. However, the claimed subject matter need not be described *in haec verba* in the specification in order for the specification to satisfy the "written description" requirement of § 112, first paragraph, *In re Smith*, 481 F.2d 910, 914, 178 USPQ 620, 624 (CCPA 1973), and all new language added by amendment is not *ispo facto* new matter. *In re Wright*, 343 F.2d 761, 767, 145 USPQ 182, 188 (CCPA 1965).

Where, as here, the specification contains a written description of the claimed invention, but not *in ipsis verbis*, the examiner, in making a rejection under the "written description" requirement of § 112, first paragraph, must meet the requisite burden of proof by providing reasons why one of

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ordinary skill in the art would not consider the description sufficient. Once the examiner has carried the burden of making out a *prima facie* case of unpatentability the burden of coming forward with evidence or argument shifts to the applicant to show that the invention as claimed is adequately described to one

skilled in the art. *In re Alton*, 76 F.3d 1168, 1175, 37 USPQ2d 1578, 1583-84 (Fed. Cir. 1996). If a person of ordinary skill in the art would have understood the inventor to have been in possession of the claimed invention at the time of filing, even if every nuance of the claims is not explicitly described in the specification, then the adequate written description requirement is met. *Id.*, 76 F.3d at 1175, 37 USPQ2d at 1584.

In this case we do not consider the reasons given by the examiner sufficient to make out a *prima facie* case of noncompliance with the "written description" requirement. In

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this regard, while it is true that the terms "first" and "second" in reissue claim 3 are broader than the terms "upper" and "lower" used in patent claim 3, this circumstance alone is not sufficient to warrant a conclusion that reissue claim 3 lacks descriptive support. See *In re Rasmussen*, 650 F.2d 1212, 1214, 211 USPQ 323, 326 (CCPA 1981)(an applicant is not limited to claiming only the specific embodiment described in the specification, but may instead claim his invention as broad as the prior art and his disclosure will allow). In the present instance, there is

nothing in the patent disclosure when read in its entirety that would lead one of ordinary skill in the art to conclude that the inventive method necessarily depends on positioning the suction cups such that they are oriented in upper and lower positions. In fact, certain passages in the patent specification that describe the invention in more general terms suggest just the opposite, i.e., that orienting the

suction cups, and the carriage members 60U, 60L that carry them, in upper and lower positions is not a necessary requirement.⁵ Accordingly, we are agreement with appellants that one of ordinary skill in the art would appreciate that the inventive method disclosed in the patent utilizes first and second rows of suction cups.

In light of the foregoing, we will not sustain the standing rejection of reissue claim 3 under 35 U.S.C. § 112, first paragraph.

Remand to the Examiner

Pursuant to 37 CFR § 1.196(e), this application is remanded to the examiner to consider the following issue:

Does reissue claim 3, which is directed to a method that includes the step of *inserting* the spread-apart

⁵See, for example, page 10, line 27, through page 11, line 5, of the specification, which reads as follows (with italics added for emphasis):

Pluralities of suction cups 66U, 66L are *disposed in aligned combination, i.e. rows, with the respective carriage members 60U, 60L along the spanwise length thereof* The suction cups 66U, 66L are operative to engage and hold the respective OML surfaces of the leading edge sheath 120 with the vacuum source 68 actuated. Subsequent synchronized movement of the respective carriage members 60U, 60L away from one another to the operating position causes spreading of the sheath 120 to facilitate insertion thereof in combination with the blade subassembly 132.

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leading-edge sheath *in combination with* the blade assembly, particularly point out and distinctly claim the subject matter which appellants regard as their invention, as required by the second paragraph of 35 U.S.C. § 112?⁶

The purpose of the requirement stated in the second paragraph of 35 U.S.C. § 112 is to provide those who would endeavor, in future enterprise, to approach the area circumscribed by the claims of a patent, with the adequate notice demanded by due process of law, so that they may more readily and accurately determine the boundaries of protection involved and evaluate the possibility of infringement and dominance. *In re Hammack*, 427 F.2d 1378, 1382, 166 USPQ 204, 208 (CCPA 1970).

In the present case, appellants seek to change by reissue the wording of the final step of method claim 3 from "*inserting* the spread-apart leading-edge sheath *onto* the blade subassembly" (patent claim 3, emphasis added) to "*inserting*

⁶It is fundamental that the description requirement found in the first paragraph of 35 U.S.C. § 112 and the definiteness requirement found in the second paragraph of 35 U.S.C. § 112 are separate and distinct. Accordingly, just because claim language may have been properly "described" in the disclosure as originally filed, it does not necessarily follow that that claim language also passes muster under the second paragraph of 35 U.S.C. § 112.

the spread-apart leading-edge sheath *in combination with* the blade subassembly" (reissue claim 3, emphasis added).⁷

Because the commonly accepted dictionary definitions of the words "inserting" and "onto" as appears in original patent claim 3 and throughout the specification are almost mutually exclusive⁸, it appears that appellants are using the word "inserting" in a way that does not comport with its plain meaning. Precisely what that meaning may be, however, is not apparent from the disclosure. Moreover, changing of the wording of claim 3 from "inserting . . . onto" to "inserting . . . in combination with" only serves to further obscure what appellants may intend the word "inserting" to mean.

Accordingly, the examiner should (1) consider whether one of ordinary skill in the art can readily and accurately determine the meaning and scope of the claimed step of "*inserting* the

⁷Appellants have also changed the wording of the preamble of method claim 3 such that the claim is now directed to a method for *inserting* a leading-edge sheath *in combination with* a blade subassembly. Suffice it to say, our remarks *infra* also extend to this terminology.

⁸ For example, the verb "insert" may mean "[t]o put or set into, between, or among," whereas the preposition "onto" may mean "[o]n top of: upon." *Webster's II New Riverside University Dictionary*, copyright © 1984 by Houghton Mifflin Company.

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spread-apart leading-edge sheath *in combination with* the blade subassembly" (emphasis added), and (2) if not, enter a new rejection of reissue claim 3 under the second paragraph of 35 U.S.C. § 112.

To summarize, the decision of the examiner finally rejecting claim 3 under 35 U.S.C. § 112, first paragraph, is reversed. The application is remanded to the examiner to consider the issue discussed above and to take appropriate action in light thereof.

REVERSED and REMANDED

HARRISON E. McCANDLISH)	
Senior Administrative Patent Judge)	
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)	BOARD OF PATENT
LAWRENCE J. STAAB)	APPEALS AND
Administrative Patent Judge)	
INTERFERENCES)	
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)	
JOHN F. GONZALES)	
Administrative Patent Judge)	

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Robert E. Cannusico, ESq.
Seidel, Gonda, Lavorgna & Monaco P.C.
Two Penn Center, Suite 1800
Philadelphia, PA 19102